

**REMARKS<sup>1</sup>**

Applicant respectfully traverses the rejection of claims 1-50, 52-60, and 62-69 under 35 U.S.C. § 102(e) for at least the reason that Tewfik fails to anticipate claims 1-50, 52-60, and 62-69. Tewfik cannot anticipate claims 1-50, 52-60, and 62-69 because Tewfik fails to disclose at least “damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis,” as recited in independent claims 1, 25, 50, and 60, and required by dependent claims 2-24, 26-49, 52-59, and 62-69.

In the Office Action mailed December 15, 2005, the Examiner acknowledges that Tewfik fails to disclose this feature, stating “[Tewfik] does not specifically teaching damping and shifting the orthogonal transform coefficient . . . .” Office Action mailed December 15, 2005, page 5. In the outstanding Final Office Action, however, the Examiner has apparently found new support for this limitation, and asserts that this feature is disclosed in Tewfik, citing to col. 8, line 21 - col. 9, line 47 for support of this assertion. The Examiner repeats her assertion in the Advisory Action mailed August 15, 2006, briefly stating “Tewfik provides support for the damping and shifting limitations of the claims.” The Examiner has not, however, either in the Final Office Action, or the Advisory Action, provided specific support as to what process of Tewfik directly corresponds to Applicant’s claimed “damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform

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<sup>1</sup>The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

coefficients in the direction of the frequency axis,” as recited in independent claims 1, 25, 50, and 60. The Examiner appears to be merely citing a large portion of Tewfik, in the hopes that something in the cited portion reads on Applicant’s claimed feature.

In taking a closer look at the specific features recited in the independent claims, claims 1, 25, 50 and 60 specifically recite “damping and shifting a predetermined number of orthogonal transform coefficients,” these coefficients being “selected from the plurality of orthogonal transform coefficients,” wherein the “damping and shifting” is performed “in the direction of the frequency axis” (emphasis added).

In the portion of Tewfik relied on by the Examiner, Tewfik discloses:

the resulting masked watermark is scaled by scale factor 44, and then in step 46 is scaled by the audio signal as each segment thereof has been weighted with a Hanning window in step 36 and as has then been extracted by an extract envelope in step 48. The resulting scaled masked watermark is in step 50 added to the audio signal . . . (col. 8, lines 59-64);

and

[t]he time-domain weighting operation attenuates the energy of the computed watermark (col. 9, lines 1-2).

To the extent that the Examiner is possibly considering Tewfik’s disclosed “weighting” and “scal[ing]” operations as corresponding to Applicant’s claimed “damping and shifting,” as recited in claims 1, 25, 50, and 60, Applicant notes that Tewfik does not disclose that either the scaling or weighting operations scale or weight “a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients,” as recited in claims 1, 25, 50, and 60. That is, Tewfik is silent as to a step or process of selecting coefficients from a group of coefficients. Tewfik thus cannot disclose that “a predetermined number of orthogonal transform coefficients,” are

“selected,” and also cannot provide a disclosure of “damping and shifting” selected coefficients. Because, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” Tewfik cannot anticipate claims 1, 25, 50, and 60 for at least this reason. MPEP § 2131 8th Ed. (Rev. 4), October, 2005 (internal citations omitted).

Moreover, again to the extent that the Examiner may be considering Tewfik’s disclosed “scal[ing]” operation as corresponding to Applicant’s claimed “shifting,” Tewfik does not disclose how the resulting masked watermark is scaled, or what the scale factor is. See Tewfik, col. 8, lines 59-64. In order to anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Id. (emphasis added). Tewfik, however, provides no disclosure of what direction, if any, the resulting masked watermark is scaled in. Accordingly, even if the “scal[ing]” operation could correspond to Applicant’s claims “shifting,” Tewfik cannot provide the necessary disclosure of “shifting . . . in the direction of the frequency axis,” as recited in claims 1, 25, 50, and 60 (emphasis added). Without this disclosure, Tewfik cannot anticipate claims 1, 25, 50, and 60 for this reason also, and the rejection of these claims under 35 U.S.C. § 102(e) should be withdrawn.

In the foregoing discussion, Applicant has demonstrated that Tewfik fails to disclose every element of at least claims 1, 25, 50, and 60. In order to clarify any outstanding issues that may need to be brought before the Board of Patent Appeals, Applicant respectfully requests that the Examiner clearly explain the outstanding rejection should it be maintained. In particular, Applicant requests that the Examiner clearly point out the disclosure of Tewfik that reads on Applicant’s claimed “damping

and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis,” as recited in independent claims 1, 25, 50, and 60.

Claims 2-24, 26-49, 52-59, and 62-69 depend from claims 1, 25, 50, and 60, and thus require all of the features recited in claims 1, 25, 50, and 60. Because Tewfik fails to disclose every feature recited in the independent claims, Tewfik also fails to disclose every feature required by the dependent claims. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 2-24, 26-49, 52-59, and 62-69 under 35 U.S.C. § 102(e).

Applicant continues to traverse the rejection of claims 1-50, 52-60, and 62-69 under the judicially created doctrine of obviousness-type double patenting, on the ground that claims 1-50, 52-60, and 62-69 are not merely an obvious variation of claims 1-26 of Sato.

Independent claims 1, 25, 50, and 60 recite a combination including at least “damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis.” Sato does not recite at least this feature, and at page 3 of the Office Action, the Examiner acknowledges that Sato “does not specifically claim damping and shifting.” To attempt to cure the deficiency of Sato, the Examiner cites Tewfik. Office Action, page 3. As discussed above, however, Tewfik fails to teach or suggest at least “damping and shifting a predetermined number of orthogonal transform coefficients selected from the plurality of orthogonal transform coefficients in the direction of the frequency axis,” as recited in independent claims 1, 25, 50, and 60, and required by

dependent claims 2-24, 26-49, 52-59, and 62-69. Tewfik thus cannot be relied upon for curing the noted deficiency of Sato.

Because Sato does not recite or suggest at least this feature, and Tewfik also does not disclose this feature, claims 1, 25, 50, and 60, and all claims that depend therefrom, are not obvious variants of claims 1-26 of Sato. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-50, 52-60, and 62-69 on the ground of nonstatutory obviousness-type double patenting.

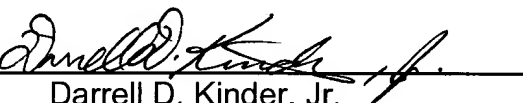
In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited by the Examiner. Applicant therefore requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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